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MAILED

JUL 08 2010

OFFICE OF PETITIONS

In re Application of :
Tong Zhang :
Application No.: 10/820561 :
Filing or 371(c) Date: 04/08/2004 :
Title of Invention: :
SINGLE-MODE OPERATION AND :
FREQUENCY CONVERSIONS FOR :
DIODE-PUMPED SOLID-STATE LASERS :

DECISION ON
PETITION

This is a decision in response to the correspondence filed March 15, 2010, requesting withdrawal of the holding of abandonment. The correspondence is properly treated as a petition under 37 CFR 1.181.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of July 15, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

Applicant filed a reply to the Office action in the form of an Amendment on October 13, 2009; however, the reply failed to place the application in condition for allowance[1]. Applicant was so notified in an Advisory Action, mailed January 22, 2010.

[1] The Amendment was not entered because the Amendment raised new issues that would require further consideration and/or search, and the Amendment was not in compliance with 37 CFR 1.173.

Applicant filed a letter and an Amendment in response to the Advisory Action on February 16, 2010; however, the letter and Amendment did not include an extension of time request or fee. No complete and proper (timely) reply to the final office action having been received, the application became abandoned October 16, 2009. A Notice of Abandonment was mailed March 20, 2010.

The present petition

Applicant files the present petition and requests withdrawal of the holding of abandonment. In support of this request, Applicant notes that the Notice of Abandonment states as the reason for abandonment Applicant's failure to timely file a proper reply to the July 15, 2009 Office action. Applicant provides that a reply was received in this Office on February 16, 2010.

Applicant next avers that the final Office action should not have been made final because the non-final Office action and the final Office action contained an erroneous citation "in the main action of the rejection for claim 10, resulted from some mistake and the misunderstanding about 'thin gain region'". Petition at p.1. Applicant notes that an explanation and detail were presented to the Examiner in Applicant's reply filed October 13, 2009. Petitioner notes that a similar rejection based upon the same misunderstanding "about 'thin gain region' was presented [in the parent application] and later the rejection and finality was "released". Petition at p.2.

Applicant also cites to the MPEP 710.06 and notes that the section provides that if the error is brought to the attention of the Office within the time period for reply the Office will set a new period for reply if requested to do so by the applicant. Petitioner avers that in the October 13, 2009 reply, Applicant indicated that the final Office action should not be made final because of an erroneous citation of reference, and that the Office should have at least set a new period for reply.

Applicant also notes that the failure to respond in a timely manner was because the office failed to mail the Advisory Action in a timely manner, as the Advisory Action was not mailed until after the expiration of the period for reply.

Finally, Applicant states that he has filed a reply in compliance with the Advisory Action on February 16, 2010 and believes that all claims are in condition for allowance.

Applicable Law, Rules and MPEP

The statute, 35 U.S.C. § 133, Time for prosecuting application, states

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

This section of the statute is further clarified in Office rule, 37 CFR § 1.135, Abandonment for failure to reply within time period, which states

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission. (Emphasis supplied).

This section explains that the reply must be both complete and proper as the condition of the application may require.

Analysis

As to Applicant's argument that the final Office action should not have been made final because the non-final office action and the final Office action contained an erroneous citation "in the main action of the rejection for claim 10, resulted from some mistake and the misunderstanding about 'thin gain region,'" Applicant notes that an explanation and detail were presented to the Examiner in Applicant's reply filed October 13, 2009. A review of Office records reveal that the Examiner considered Applicant's reply to the final Office action filed October 13, 2009, and thereafter mailed an Advisory Action on January 22, 2010, wherein Applicant was informed that the reply raised new issues that would require further consideration and/or search. In addition, the Advisory Action informed Applicant that the reply was not fully responsive to the final Office action, and advised Applicant to file an Amendment with all the claims (1-15) and follow the guidelines of 37 CFR 1.173.

Applicant provides in the present petition that he has filed a reply in compliance with the Advisory Action on February 16, 2010 and believes that all claims are in condition for allowance: however, the reply filed February 16, 2010, required an extension of time request and fee in order to have been considered timely.

Applicant's arguments have been carefully considered. Applicant argues both that the Office action should not be made final because of a mistake and/or misunderstanding, and that he has filed a reply in compliance with the Advisory Action on February 16, 2010. However, the Advisory Action explained why the reply filed October 13, 2009 was not a complete and proper reply to the Office action. Applicant's statement that he has filed an amendment with all the claims (1-15) and followed the guidelines of 37 CFR 1.173, and believes that all claims are in

condition for allowance in compliance with the Advisory Action on February 16, 2010, is an acknowledgement that the reply filed October 13, 2009 was not a complete and proper reply as the condition of the application required. Applicant has therefore failed to demonstrate that the holding of abandonment is improper and should be withdrawn.

The petition is dismissed.

Alternate Venue

Applicants are strongly urged to file a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Finally, Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is further advised that the Office of Independent Inventors and the Patent Assistance Center, at 1-800-786-9199, are available to provide assistance in prosecuting patent applications.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

Enclosure: Petition for Revival of an Application for Patent Abandoned Unintentionally